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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,855	02/14/2001	Dann LeRoy Parker JR.	20526Y	9302

210 7590 11/17/2003

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RAHWAY, NJ 070650907

EXAMINER
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COVINGTON, RAYMOND K

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 11/17/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/782,855

Applicant(s)

PARKER ET AL.

Examiner

Raymond Covington

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-21 and 32-40 is/are allowed.
- 6) ☒ Claim(s) 1-9 and 22-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

The rejection of claims 19-21 under 35 USC 112 has been withdrawn in light of applicants' amendment.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 and 22-31 are rejected under 35 U.S.C. 112, first paragraph. The rejection is maintained for reason of record. Applicants' comments have been noted and considered but are not persuasive of patentability.

The specification does not give any guidance as to enable the full range of compounds encompassed by the recited claims. In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described.

They are:

1. The nature of the invention,
2. The state of the prior art,
3. The predictability or lack thereof in the art,
4. The amount of direction or guidance present,

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5. The presence or absence of working examples,
6. The breadth of the claims,
7. The quantity of experimentation needed, and
8. The level of the skill in the art.

The specification, while being enabling for non-heterocyclic substituted compounds, does not reasonably provide enablement for heterocyclic substituted derivatives other than pyridine, piperidine, thienyl, imidazole, pyrazole, oxazole, isoxazole, thiazole, pyrrole, morpholine, furyl, pyridazine, pyrimidine, purazinyl, benzimidazole, indole, purine, and thiazole, in particular N-heterocyclic derivatives, were prepared or obtained. The process of making the heterocyclic substituted derivatives or how the heterocyclic substituted derivatives were obtained is not readily apparent from the specification. The specification must teach how to make the invention. *In re Gardner*, 166 U.S.P.Q. 138 (1970). In order to practice the claimed invention, one skilled in the art would have speculate how the derivatives were obtained or prepared. There is insufficient disclosure of starting materials that would place such a diverse genus of compounds in possession of the public in the event of a patent grant. In addition, there is no reasonable assurance that such an alleged genus of compounds would possess all of the alleged properties for use. See *In re Fouche* 169 USPQ 429 ((CCPA 1971)).

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Therefore, the instant invention is not enabled. Claims limiting the scope of these terms should overcome this rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cragoe Jr. et al US 4,731,471 and /or Conn et al 4,704,472.

Both Cragoe Jr. et al and Conn et al both teach fluorenone derivatives as claimed.

Patentees differ in that all of the species encompassed by the recited claims.

However, it would have been obvious to one of ordinary skill in the art to modify the teachings of the cited references to obtain other analogous compounds such as the, for example, heterocyclic substituted analogous compounds claimed.

Claims 10-21 and 32-40 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Covington whose telephone number is (703) 308-4704. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. Rotman can be reached on (703) 308-0204. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7922.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

*RKC*

RKC

Raymond Covington  
Examiner  
Art Unit 1625

*Alan L. Rotman*

ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600